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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/258,123	02/26/1999	ROBERT T. BURGER	107227.00102	3397

32127 7590 10/24/2003

VERIZON CORPORATE SERVICES GROUP INC.  
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EXAMINER

ROBINSON, GRETA LEE

ART UNIT	PAPER NUMBER
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2177

DATE MAILED: 10/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/258,123

Applicant(s)

BURGER ET AL.

Examiner

Greta L. Robinson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12,25-53 and 68-84 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12,25-53 and 68-84 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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### DETAILED ACTION

1. Claims 1-12, 24-39, 40-53 and 68-84 are pending in the present application.
2. Claims 13-24 and 54-67 were canceled; and claims 1, 9, 25, 43, 68 and 71 have been amended.

### *Drawings*

3. The corrected or substitute drawings were received on July 30 2003. These drawings are approved.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-12, 25-39 and 68-84 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 1, "*parsing the page-heading data to produce an index*" [claim 1 line 12]. The disclosure does not appear to describe a method for producing an index. The disclosure

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makes reference to an index on page 10, citing that "the files should preferably be indexed somehow", but does not go into detail as to generating or producing an index [see page 10 lines 12-16]. Claims 2-12 are rejected based on dependency.

Regarding claim 25, "*an index representing an organization of the document*" [note claim 25 line 9]. Again as cited above, the disclosure does not appear to describe an index representing an organization of the document, but rather is simply described as an integral part of retrieving data [note page 10 lines 12-16]. The Examiner is unable to find other citations of the use of the index other than on page 10 of the specification. Claims 24-39 are rejected based on dependency.

Also, regarding claims 25 and 68, the limitation "*a capturing device*" [see claim 25 lines 14-15; claim 68 line 16-17], the disclosure does not describe a capturing device; but rather makes reference to a "*captured/electronic directory package host 211*" note page 11 line 22 and figure 2. Claims 24-39 and 69-84 are rejected based on dependency.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-12, <sup>claim</sup>20, 40-53, <sup>as amended</sup>57-60, and 71-74 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Regarding independent claims 1 and 40, the following limitation is vague: “converting the printing data in the print queue into .... by *capturing the printing data from the printing queue and not by producing or scanning hard copies of the print data*”[see: claim 1 line 7; claim 40 line 11-15]. Claims 2-12 and 42-53 are rejected based on dependency. The disclosure makes reference to “the converter/archiver host 217 converts the EDS files into image files” note page 12. The added limitation is vague and the conversion process does not appear to correspond with **page 9 lines 15-20** description of a *converter program* running in the batch mode or **page 11-12** *converter/archive host* that converts the data. The disclosure does not appear to state that the conversion takes place in the print queue. Claims 2-12 and 41-53 are rejected based on dependency.

### ***Response to Arguments***

8. In the response Applicant argued the following: Claims 1-12, 20, 40-53, 57-60 and 71-74 were rejected under 35 USC 112 second paragraph, and claims 13-39 and 68-84 under 35 USC 103(a) Applicant has amended the claims to overcome the rejection.

In response to Applicants amendment note new citation under 35 USC 112 first and second paragraph above. The rejection under 35 USC 103(a) has been dropped in view of the amendment and Applicant's remarks.

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9. Applicant's arguments with respect to claims 1-12, 25-39, 40-53 and 68-84 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Yokomizo et al.** US Patent 5,907,835

**Heindel et al.** US Patent 6,304,857 B1

**Kato et al.** US Patent 6,631,495 B2

**Zufle** US Patent 5,940,584

**Warnock et al.** US Patent 5,634,064

**Michelman et al.** US Patent 6,128,633

**Antonacopoulos et al.** *Segmentation and Classification of Document Images*

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greta Robinson whose telephone number is (703)308-7565. The examiner can normally be reached Monday through Friday from 9:30 AM to 6:00 PM. If any attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene, can be reached at (703) 305-9790.

**Any response to this action should be mailed to:**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**or faxed to: (703)872-9306**

Hand delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington, VA., fourth Floor (Receptionist). Any inquiry of a general nature or relating to the

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status of this application should be directed to the Group receptionist whose telephone number is (703)305-9600.

A handwritten signature in black ink, appearing to read 'G. Robinson', is written over the printed name 'GRETA ROBINSON'.

**PRIMARY EXAMINER**

Greta Robinson

Primary Examiner

October 15, 2003